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10/549,728

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Per-Ola Vallebrant

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EXAMINER

KERSHTEYN, IGOR

ART UNIT

PAPER NUMBER

3745

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,728	<b>Applicant(s)</b> VALLEBRANT ET AL.	
	<b>Examiner</b> Igor Kershteyn	<b>Art Unit</b> 3745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 4, 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the narrowing" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 7,487,706. Although the conflicting claims are not identical, they are not patentable distinct from each other because claim 5 of the Patent anticipates Application claim 1. Accordingly,

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Application claim 1 is not patentably distinct from Patent claim 5. Here, Patent claim -- requires:

*An arrangement for controlling a hydraulically driven motor (2), forming part of a hydraulic system in which hydraulic fluid under pressure forms a main flow through a main duct (1) in which the motor is connected, the motor being adapted to drive a load with varying loading, and one or more valves (6, 7) being adapted for controlling the hydraulic fluid flow through the motor during operation and also for starting and stopping of the motor, characterized in that one of the valves comprises a spool-type flow control valve (7) which is connected in the main duct (1) downstream of the motor (2) and is adapted for starting and stopping the motor and flow control providing substantially constant flow rate of the hydraulic fluid through the motor under varying loading, characterized in that the spool-type flow control valve (7) is integrated with a motor housing.*

While Application claim 1 requires:

*An arrangement for controlling a hydraulically driven motor, forming part of a hydraulic system in which hydraulic fluid under pressure forms a main flow through a main duct in which the motor is connected, the motor being adapted to drive a varying load, and one or more valves (6, 7) being adapted for controlling the hydraulic fluid flow through the motor on the one hand during operation and on the other hand for starting and stopping of the motor, one of the valves consisting of a flow control valve (7) which is connected in the main duct (1) downstream of the outlet of the motor, characterized in that the flow control valve (7) is integrated with the motor housing (50). Thus it is*

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apparent that more specific Patent claim 5 encompasses Application claim 1. Following the rationale in *In re Goodman* cited in the above paragraph, where Applicant has once been granted a patent containing a claim for the specific or narrower invention, Applicant may not obtain a claim for the second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim 1 is anticipated by Patent claim 5 and since anticipation is the epitome of obviousness, then Application claim 1 is obvious over Patent claim 5.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panissidi (2,878,015) in view of Dietiker (3,565,208).

Panissidi, in figure 1, teaches an arrangement for controlling a hydraulically driven motor 22, forming part of a hydraulic system in which hydraulic fluid under pressure forms a main flow through a main duct 21,25 in which the motor is connected, the motor being adapted to drive a varying load, and one or more valves 40 being adapted for controlling the hydraulic fluid flow through the motor on the one hand during operation and on the other hand for starting and stopping of the motor, one of the valves

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consisting of a flow control valve (7) which is connected in the main duct (1) downstream of the outlet of the motor.

Panissidi doesn't teach the flow control valve is integrated with the motor housing.

Dietiker, in figures 1-7, teaches a motor, having a housing 10, and a flow control valve 86,88, the flow control valve is integrated with the motor housing.

Since Panissidi and Dietiker are analogous art, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to integrate the flow control valve of Panissidi with the housing as taught by Dietiker for the purpose of compactness.

#### ***Allowable Subject Matter***

Claims 4, 6, and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Prior Art***

Prior art made of record but not relied upon is considered pertinent to Applicant's disclosure and consist of one patent.

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Fawkes (2,392,980) is cited to show a motor having a stroker mechanism integrated into the housing of the motor but fails to teach a flow control valve.

***Contact information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Kershteyn whose telephone number is (571) 272-4817. The examiner can normally be reached on regular.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Look can be reached on (571)2724820. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Igor Kershteyn/  
Primary Examiner, Art Unit 3745

Igor Kershteyn  
Primary Examiner  
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